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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,270	05/02/2001	Palpu Pushpangadan	056859-0126	6119

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FOLEY AND LARDNER
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WASHINGTON, DC 20007

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,270

Applicant(s)

PUSHPANGADAN ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/6/03
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 71-148 is/are pending in the application.
- 4a) Of the above claim(s) 82, 104-106, 108, 114, 120-148 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 71-81, 83-103, 107, 113-119 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

Claims 71-119 are pending. Claims 82, 104-106, 108-114 and 120-148 are withdrawn from consideration, as they are directed toward non-elected subject matter.

The Amendment filed 11/6/03, amended claims 90 and 100, and added claims 120-148. The Amendment to claims 90 and 100 is sufficient to overcome the 35 USC 112 rejection in the previous Office Action.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/6/03 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 71-81, 83-100, 103, 107, 115-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz (2002/0082279) in view of Tu (CN 1113773).

The instant invention is directed toward a composition comprising an herbal colorant selected from the general of the family Boraginaceae and an additive selected from essential oils/aroma isolates selected from a group of plant species.

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Schultz teaches a composition for the treatment of dermatologic diseases comprising an active agent, essential oils, and a carrier. The composition is taught as treating acne, dermatitis, wrinkles and other disorders. Citronella (synonym for cymbopogon nardus), basil (synonym for ocimum basilicum), and jasmine are taught as essential oils with direct skin effects for use in his composition. The essential oils are further taught as moisturizing the skin. See [0003]-[0019]. The reference lacks macrotomia and preferred percent weights.

Tu teaches a cosmetic composition comprising natural plant extracts for the treatment of acne, folliculitis, dermatitis, and wrinkles. Arnebia (synonym for Macrotomia) is taught as a plant extract. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the Macrotomia taught by Tu into the composition of Schultz because of the expectation of achieving a composition that potently treats acne and because it is obvious to combine two compositions taught by the prior art to be useful for the same purpose to form a third composition that is to be used for the very same purpose. In re Kerkoven, 205 USPQ 1069 (CCPA 1980).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the amounts of the active ingredients in the combined references because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

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Claims 101-102 rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz in view of Tu as applied to claims 71-81, 83-100, 103, 107, 115-119 above, and further in view of Benford (5,110,593).

Schulz and Tu are applied as discussed above. The references do not teach beeswax.

Benford teaches a composition for treating dermatitis, such as acne. Beeswax is disclosed as the carrier. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the carrier of the combined references as beeswax because a) the combined references teach a composition for treating acne and Benford teaches beeswax as a carrier for use in topical compositions for treatment of acne; and b) because of the expectation of achieving a composition wherein the base is topically safe and does not further aggravate acne.

The Examiner respectfully points out a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case the intended use of the composition claims have not been afforded patentable weight.

It is further respectfully pointed out that many claims are directed to the properties of a compound. The Examiner respectfully points out that a compound and its properties are inseparable (*In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)).

Response to Arguments

Applicant argues, "The composition of the present invention comprises a synergistic mixture of herbal colorants, essential oils/aroma isolates. . .which satisfies the applicants expectation of a safe, eco-friendly, non-toxic beautifying cosmetic composition having wider applications/adaptations". This argument is not persuasive. First, it is respectfully pointed out that Applicant has provided no data of synergy that is unexpected over the prior art. Second, it is respectfully pointed out that Applicant's argument is not commensurate in scope with the claimed invention, as the claimed invention is directed to a composition and not to an expectation of certain properties.

The Examiner respectfully points out that Applicant has argued the references individually, when the rejection was made over a combination of references. It is respectfully pointed out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Additionally, it is respectfully pointed out that Applicant has provided no arguments toward the references of Schultz or Benford.

Applicant argues, "The second citation of Tu provides a composition that can be used as skin protectant thereby limiting itself to therapeutic effects. . .However, the present invention has increased scope by application of the natural extracts in the forms of creams, eyelashes. . .rouges, etc". This argument is not persuasive, as it is not commensurate in scope with the instant claims. First, the instant claims are directed to a composition and not to a method of applying the

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composition. Second, the instant claims do not contain any limitations to forms of the composition.

Applicant argues, "Further, the applicants bring to the Examiners attention that present composition is for aesthetic impression of cosmetics for short period. Tu does not disclose a composition of herbal colorant, rather it discloses a composition which has medicinal property". This argument is not persuasive. First, this argument is not commensurate in scope with the instant claims, as the instant claims are not limited by an aesthetic impressions. Second, it is respectfully pointed out that a compound and its properties/a combination of compounds and their properties are inseparable. Thus, while Tu does not explicitly state macrotomia as being an herbal colorant, the compound still has this property. Additionally, it is respectfully pointed out that the motivation for combining references is not limited to Applicant's characterization of the properties of the compounds.

Applicant argues that there is no motivation to combine the references, but fails to specifically point out why the rejection is lacks motivation.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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Applicant argues, "with respect to a preferred embodiment of the present invention, adding acids and bases can change the color of the composition. The specification clearly states that the intensity can be enhanced or reduced by adding inorganic acids or bases and thus is pH dependent". This argument is not persuasive. First, this argument is not commensurate in scope with the instant independent claims. Second, it is again respectfully pointed out that the motivation for adding a chemical compound ingredient to a composition is not limited to Applicant's characterization of the properties of the compound. Third, it is respectfully pointed that it is well known in the art that adding acids and bases to chemical compositions can change the color of the compositions.

Applicant argues that the rejection teaches away from the instant invention by arguing that the instant composition is pharmaceutical and not dermalogical. This argument is not persuasive. The Examiner respectfully points out that the instant invention and the cited references are all directed to applying a composition to the skin to provide a benefit.

Conclusion

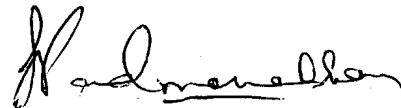
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



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